



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,196	04/05/2001	Edwin S. Flores	1861-1001	5382

7590 02/26/2003
Sanford E. Warren, Jr.
GARDERE WYNNE SEWELL LLP
Suite 3000
1601 Elm Street
Dallas, TX 75201

EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
----------	--------------

1714

DATE MAILED: 02/26/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,196

Applicant(s)

FLORES, EDWIN S.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1714

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following: Paragraph 14 supposed to contain a "Brief Description of the Drawings". There are no drawings in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims claim polyisocyanate polymers and acetoacetate polymers. The specification in paragraphs 24, 25 and 35 only shows polyisocyanate functional polymers and acetoacetate functional polymers. Paragraphs 32 and 34 show polyisocyanate and acetoacetate monomers. Clarification is required.

4. Claims 11-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for anhydrous structural fillers, does not reasonably provide enablement for non-anhydrous structural fillers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly

Art Unit: 1714

connected, to make and use the invention commensurate in scope with these claims.

See paragraph 22, last three lines.

5. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for anhydrous fillers, does not reasonably provide enablement for moisture containing fillers. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See paragraph 22, last three lines.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. The meaning of "structural fillers" is not known. Only cement and gypsum are mentioned in the specification. No other pozzolanic or non-pozzolanic fillers are shown.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-22 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shearing 3,763,070, Shearing

Art Unit: 1714

3,772,051, Shearing 3,977,889, Alexander 4,127,548, Kossatz et al. 4,902,348, Tsai et al. 5,807,431 or Laas et al. 6,007,619, in view of Ikemoto et al. 5,932,344.

11. Shearing ('070) discloses cement and isocyanate in claim 1. Shearing ('051) teaches isocyanate and hydraulic cement in the Abstract. So does Shearing ('889). Alexander recites hydraulic cement and polyisocyanate in the Abstract. Kossatz et al. divulge polyisocyanate in the Abstract and gypsum in claim 1. Tsai et al. reveal polyurethane, cross-linking agent and cement in claim 1. Laas et al. display polyisocyanate in the Abstract and Portland cement in the Examples. Ikemoto et al. present the conventional cement additives (retarder, stabilizer, rheological agent, coloring agent and plasticizer) claimed by applicant, in the Abstract, column 9, lines 56-64 and column 18, lines 15-22. For Portland cements, see the paragraph overlapping columns 17 and 18. Applicant's claims are not novel. In the alternative, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to use the additives of Ikemoto et al, in the compositions of the primary references, because said additives are customarily used in water-settable compositions. The kit is identical to the composition. The method steps are nominal. Applicant can overcome these references by specifying that the compositions are anhydrous.

12. Claims 1-22 are rejected under 35 U.S.C. 102(a or b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Szukiewicz 2,902,388, Shearing 4,211,680, Stark et al. 5,021,537, Abdelazig et al. 5,326,396, von Bonin 5,374,448 or Toray Ind. JP-9-302239 in view of Ikemoto et al. 5,932,344.

Art Unit: 1714

13. Szukiewicz describes a polyisocyanate adduct of a polymer and hydraulic cement in claims 1-15. Shearing ('680) discusses polyisocyanate and Portland cement in column 2, lines 56-58. Stark et al. relate polyacetoacetate in the title and Portland cement in column 4, lines 7-8. Abdelazig et al. report cement in claim 5 and butylacetoacetate in claim 8. Von Bonin lists Portland cement in claim 9 and isocyanates in claim 10. Toray Ind shows moisture-curable resin with cement in the Abstract. The contents of Ikemoto et al. have been discussed already. Applicant's claims are not novel. In the alternative, it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to use the additives of Ikemoto et al. in the compositions of the primary references, because said additives are customarily used in water settable compositions. The kit is identical to the composition. The method steps are nominal.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is 703-308-2460. The examiner can normally be reached on Tuesday-Friday 7:00 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Application/Control Number: 09/827,196

Page 6

Art Unit: 1714

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
February 20, 2003